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Paper No. 7

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APR 11 2003

OFFICE OF PETITIONS

In re Application of  
Keith et al.  
Application No. 10/024,701  
Filed: December 17, 2001  
Attorney Docket No. 13764-003001

DECISION REFUSING STATUS  
UNDER 37 CFR 1.47(a)

This is in response to the petition filed November 6, 2002, under 37 C.F.R. §1.47(a) (certificate of mailing date October 28, 2002).

The petition under 37 C.F.R. §1.47(a) is DISMISSED.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on December 17, 2001, without an executed oath or declaration. Accordingly, on March 27, 2002, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration in compliance with §1.63, and a surcharge for its late filing. This Notice set an extendable two-month period for reply of May 27, 2002.

In reply, applicant filed a petition, the surcharge for late filing of the declaration, the Declaration of Timothy Douros of Cubist Pharmaceuticals, Inc, and a partially executed declaration. To make timely a request for a five (5) month extension of time was submitted with the petition.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The instant petition does not satisfy requirements (1).

As to item (1), Rule 47 applicant has failed to show that the non-signing inventors Govardhan and Khalaf refused to sign the declaration after having been presented with the application papers (specification, including claims, drawings, and oath or

declaration). See MPEP 409.03(d). The declaration of Timothy Douros states the application papers were forwarded to Richard Forrest General, Counsel for Altus. However, sufficient evidence that the documents were presented to the inventors has not been provided. There is no indication rule 47 applicant inquired as to whether the application papers were forwarded to the inventors. Nor is there any indication rule 47 applicant provided a copy of the application papers to inventors Govardhan and Khalaf at their last known addresses. Furthermore, no evidence has been presented that the inventors are represented by Richard Forrest. Before a refusal can be alleged, applicant must demonstrate a bona fide attempt was made to present a copy of application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor.

Thus on renewed petition, rule 47 applicant must establish the **entire** application package (including specification, claims and drawings) was presented to the non-signing inventors and they refused to sign.

Deposit account 06-1050 has been charged the \$130.00 petition fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                   Commissioner for Patents  
                                 Box DAC  
                                 Washington, D.C. 20231

By FAX:                   (703) 308-6916  
                                 Attn: Office of Petitions

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                                 2201 S. Clark Place  
                                 Arlington, VA 22202

Telephone inquiries related to this decision may be directed to the undersigned at (703) 306-0251.

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